

REMARKS

This amendment is responsive to the outstanding Office Action, and is accompanied by a Request for Continued Examination (RCE) and RCE fee, under 37 CFR 1.114. Entry of the foregoing amendment and consideration of the amendment is therefore respectfully requested.

Rejections Under 35 U.S.C. § 102(b)

The Office Action has rejected claims 1-6, 9, 12, 13, 17, 20-25, 33, 35-38, 40, 41, 44-46, 48, 49, 52-54, 56-57, 60-67, 69-76, 79-137 under 35 U.S.C. § 102(b) as being anticipated by Sherwin et al. (US 2002/0052784).

Rejections Under 35 U.S.C. § 103(a)

The Office Action has also rejected claims 7-11, 14-16, 18, 19, 26-29, 30-32, 34, 39, 42, 43, 47, 50, 51, 55, 58, 59, 68, 77 and 78 as obvious over Sherwin et al. (US 2002/0052784).

Applicants have deleted claims 1-137. As such, the rejections in the office action are now moot. New claims 138 - 161 have been added. No new matter has been added.

To anticipate a claim under 35 U.S.C. sections 102(a), (b), or (e), the reference must teach each and every element as set forth in the claim, either expressly or inherently described, in a single prior art reference." (Emphasis added) (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631; see also MPEP 2131.) "The identical invention must be shown in as complete detail as is contained in the claim." (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); see also MPEP 2131.) Further, any claim depending from base claims not anticipated or made obvious by the prior art also are not anticipated or made obvious by the prior art since the dependent claims comprise all of the elements of the base claim.

The Sherwin publication does not teach each and every element of newly added independent claims 138, 155 and 158. Specifically, Sherwin fails to teach or suggest a

system or method that associates a user with a beneficiary group, associates a provider with a beneficiary group, allows a user to enter parameters into a database and then compares the parameters to select a provider to provide one of a good, service and information defined in the search request. Furthermore, Sherwin fails to teach or suggest adapting the database to be searched in expandable synergistic concentric circles formed based upon the search request and associated beneficiary group of the user. In the present invention, a user directed search system and method is provided. The search system and method associates a user with at least one beneficiary group and associates the beneficiary groups with at least one provider. When a user performs a search, the user enters search request parameters and beneficiary input parameters into a database. The parameters are compared and a provider or providers that most closely fits the parameters entered are selected. The providers are selected through an open system. Additionally, the present invention provides a search arrangement, which includes an expandable synergistic concentric circle arrangement.

On the other hand, Sherwin is directed toward an affinity shopping portal. In Sherwin, a shopper enters a first web-site that has an affinity group and from the first web-site, the shopper is forwarded to a second web-site, both of which are maintained on a communication network. When the shopper is forwarded to a new web-site, a click-through fee is generated and a portion of this fee is distributed to the affinity group that is associated with the shopper. (See abstract) The shopper is associated only with a set number of affinity groups, thus creating a closed system. Within this closed system, merchants are registered with a coordinator or individual affinity group to have hyper-links to their online web-sites included in selected ones or in all the affinity group shopping sites or web pages maintained and/or administered by the coordinator. As a result, shoppers are limited to the affinity groups in the closed system.

Nowhere does Sherwin teach or suggest a user directed search in an open system where a user is able to select from an unlimited number of providers or a search arrangement, which includes an expandable synergistic concentric circle arrangement.

Furthermore, Sherwin does not teach or suggest a user entering parameters in a search request and the system and method comparing the parameters to select a provider or providers for the user. In fact Sherwin teaches away from a user directed

search in that a user cannot enter specific parameters, a shopper in Sherwin is limited to the hyper-links on the websites of the affinity groups.

Therefore, Applicants' invention, as claimed in newly added independent claims 138, 155 and 158 are different than the cited prior art in that in the present invention allows a user to enter parameters in a search request and the system and method compares the parameters to select a provider or providers for the user. Additionally the cited prior art fails to teach or suggest a search arrangement, which includes an expandable synergistic concentric circle arrangement.

In view of the above, Applicants respectfully request allowance of independent claim 138, 155 and 158 and subsequently claims 139-154, 155-157 and 159-161 which depend therefrom. If the Examiner believes that a telephone conference with Applicants' representative might expedite prosecution of the application, she is cordially invited to call at the number listed below.

Respectfully submitted,

Dated: 5/27/05

By: Heidi L. Eisenhut
Heidi L. Eisenhut
Attorney for Applicant
Registration No. 46,812

GORDON & REES LLP
101 West Broadway, Suite 1600
San Diego, CA 92101
Telephone: (619) 696-6700
Facsimile: (619) 696-7124

Docket No. GCGL 1033296